

REMARKS

The above-identified Office Action dated September 2, 2004, contained a final rejection of claims 1-4 and 6-23. Minor non-substantive amendments have been made to claims 1 and 4. Therefore, the Applicants submit that a new search will **not** be required by the Examiner. As such, the foregoing amendments to the claims and the remarks below are intended to place the case in condition for allowance, or alternately in better form for consideration on appeal under 37 CFR 1.116. Therefore, it is respectfully requested that the amendments to claim 1 be entered despite the finality of the present rejection.

In a single rejection, the Examiner used six (6) references as the basis to reject the claims 1, 2, 4, 6, 7, 10, 20, 21 and 23. Namely, the Examiner rejected claims 1, 2, 4, 6, 7, 10, 20, 21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. (U.S. Publication No. US2002/0071559) in view of Nunley et al. (U.S. Patent No. 4,404,649) and further in view of Blumenthal et al. (U.S. Patent No. 5,784,460) and further in view of Wiegley (U.S. Patent No. 6,711,677) and further in view of Sansone (U.S. Patent No. 6,373,587) and further in view of Nishikawa (U.S. Pub. No. 20020048039).

In addition, in another single rejection, the Examiner used seven (7) references as the basis to reject claims 3 and 22. In particular, the Examiner rejected claims 3 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Nunley et al. and further in view of Blumenthal et al. and further in view of Wiegley and further in view of Sansone and further in view of Nishikawa and further in view of Chan et al. (U.S. Patent No. 6,378,070).

Also, the Examiner rejected claims 12, 13, 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Rosenberg et al. (U.S. Patent No. 6,363,357) and further in view of Wiegley and further in view of Sansone and further in view of Nishikawa. The Office Action rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Rosenberg and further in view of Sansone. Last, the Office Action rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of

Rosenberg and further in view of Sansone and further in view of Blumenthal et al.

The Applicant respectfully traverses these rejections based on the arguments below.

First, the Applicant submits that the cited combined references do not disclose, teach or suggest the Applicant's claimed invention. Namely, the combined cited references do not disclose the Applicant's decrypting at the printer a first portion of the partially encrypted file, printing at least a second portion of the partially encrypted file using a serialized print methodology that includes having the printer generate a unique serialized print number for the document file in the course of printing the document file and printing at least a portion of the decrypted document file using a guaranteed print methodology that includes sending the first computer information about the number of printed pages and output print quality of the document file.

Even though the combination of the cited references does not produce all of the elements of the claimed invention, these references should not even be considered together since there is no motivation to combine the cited references. It is well-settled law that there must be a basis in the references for combining or modifying the references. Namely, the Examiner cannot arbitrarily "pick and choose" elements from numerous references and combine these elements using hindsight.

The Examiner is reminded that the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). The Examiner's use of hindsight is evidenced by the fact that the Examiner used six (6) references for a single rejection and seven (7) references for another single rejection. Contrary to the Examiner's "shopping spree" approach, the Applicant's submit that there must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination. **That knowledge cannot come from the applicant's invention itself.** In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) [emphasis added].

Further, "[T]he genius of invention is often a combination of known elements

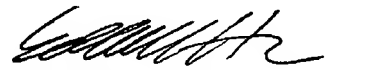
which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references." Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the reference in question seems relatively similar "...the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses numerous references. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [emphasis added]. Since the Examiner's rejection is clearly based on hindsight, the rejection is improper and must be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.

With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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